

REMARKS

By this Amendment, claim 10 is canceled. Thus, claims 1, 3-9, and 11-23 are pending in this application. Applicant respectfully requests reconsideration and prompt allowance of the pending claims at least in light of the following remarks.

Applicant respectfully submits that entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments simply cancel claim 10; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal (should an appeal be necessary) by canceling a rejected independent claim and thereby narrowing the issues for appeal. Applicant respectfully requests entry of the amendments under 37 CFR §1.116.

Applicant gratefully acknowledges the indication that claims 4, 7-9, 13, and 14 are allowable and claims 11, 12, and 15-22 are allowed. However, Applicant respectfully maintains that all of the pending claims are allowable for the reasons discussed below.

The Final Rejection rejects claim 10 under 35 U.S.C. §102(e) over U.S. Patent No. 6,454,390 to Takahashi et al. (Takahashi). As claim 10 is canceled, the rejection is moot. Applicant respectfully requests withdrawal of the rejection.

The Final Rejection rejects claims 1, 3, 5, 6, and 23 under 35 U.S.C. §103(a) over Takahashi in view of U.S. Patent No. 6,215,562 to Michel et al. (Michel). Applicant respectfully traverses the rejection.

As acknowledged by the Final Rejection, Takahashi at least fails to disclose reprinting the selected best test pattern from the scanned-in test patterns on the printing medium, as recited in claim 1 and similarly recited in claim 23.

Michel fails to make up for this deficiency of Takahashi. In particular, Michel discloses that every time a color patch and a brightness patch are selected by the user, a new Gray Balance page is reprinted with the selected color patch as the middle patch 125 (C7/L3-6 and L39-40 and Figs. 3A-3B). Importantly, once the best pattern is determined, it is not reprinted (C7/L6-9 and L39-42 and Figs. 3A-3B). Furthermore, in Michel, the selected test pattern is not printed on the same printing medium as required by, claims 1 and 23. Rather, each time a new Gray balance page is printed (C7/L3-6 and L39-40 and Figs. 3A-3B).

Because both Takahashi and Michel fail to disclose reprinting the best patch on the printing medium, claims 1 and 23 are patentable over the combination of Takahashi and Michel. Further, claims 3, 5, and 6 are patentable for at least the reasons that claim 1 is patentable, as well as for the additional features they recite. Applicant respectfully requests withdrawal of the rejection.

Finally, with respect to claim 23, the Final Rejection has not met its burden for a prior art rejection. In particular, all positively recited features of a claim must be addressed in an Office Action. In re Angstadt et al., 190 USPQ 214 (CCPA 1976); In re Alul et al., 175 USPQ 700 (CCPA 1972); and General Electric Company v. U.S., 198 USPQ 65 (US Cl.Ct 1978). Furthermore, when rejecting a claim based on prior art, the Examiner must designate the particular part of the reference relied on as nearly as practicable. 37 C.F.R. §1.104(c)(2).

The Final Rejection has failed to meet the above requirements with respect to claim 23 by failing to address the feature of claim 23 wherein "the image printed on the printing medium includes a confirmation pattern that corresponds to the selected best test pattern and its number of shift dots" and by failing to indicate the portion of the applied references relied on as disclosing such a feature.

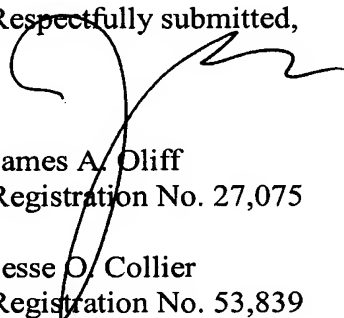
Because, the rejection of claim 23 is deficient, Applicant respectfully submits that the Final Rejection is improper. That is, claim 23 has not yet received the examination to which

it was entitled. Should the Examiner decide to maintain the rejection of claim 23, Applicant respectfully requests that prosecution be reopened and a new rejection properly addressing all of the features of claim 23 be asserted.

In view of at least the foregoing, Applicant respectfully submits that this application is in condition for allowance. Applicant earnestly solicits favorable reconsideration and prompt allowance of the pending claims.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, Applicant invites the Examiner to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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Date: January 3, 2007

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